

U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,282,028 to Johnson et al. (hereinafter referred to as "Johnson") in view of U.S. Patent No. 5,336,870 to Hughes (hereinafter referred to as "Hughes"). Specifically, the Examiner states that, with reference to claim 1, Johnson discloses a remote control device for controlling an interactive receiver unit in that Johnson has a housing, a keypad, a control means, a switch means and a transmitter means. The Examiner acknowledges that Johnson does not disclose a memory for storing financial information of the user and transmitting the financial information to the receiver unit as recited in the claim.

The Examiner argues, however, that Hughes discloses a handheld terminal and a memory for storing financial information of the user. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Johnson's system to include a memory for storing financial information of the user and transmitting the financial information to the receiver unit, as taught by Hughes for the advantage of information which facilitates faster data rate, redundancy or transmission of different data formats.

Regarding claim 2, the Examiner states that the combined system of Johnson and Hughes fail to disclose transmitting the financial information on a communication channel different from the communication channel used to transmit the programming selections as recited in the claim. However, the Examiner maintains that it is notoriously well-known in the art that a single frequency is used for a serial transmission and multiple frequencies are used for parallel transmission, and argues that it would have been obvious to one of ordinary skill in the art to

modify the combined system of Johnson and Hughes to include transmitting the information on a communication channel different from the communication channel used to transmit the programming selections.

The Examiner states that claim 6 and 7 are met by the combined system of Johnson and Hughes which disclose a slot for swiping a card containing financial information of the user. Claims 51-55 are rejected for the same reasons. The Examiner also states that claim 8 is met because it would have been obvious to one of ordinary skill in the art to include a QWERTY keypad to the combined system of Johnson and Hughes. The Examiner rejected claim 9 by stating that the hand held remote control device is disclosed by the combined system. The Examiner further maintains that claim 46 is rejected because the combined system discloses a game provided by the remote control and/or receiver unit. Lastly, the Examiner rejected claim 47 because, although the combined system of Johnson and Hughes fail to disclose that the interactive receiver is positioned within a television set, that it would have been obvious to one of ordinary skill in the art to do so.

Paragraph 3 of the Office Action rejects claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Johnson and Hughes, and further in view of Krisbergh. Specifically, the Examiner acknowledges that the combined system of Johnson and Hughes fail to disclose that the device comprises the handset of a phone for dialing phone numbers from the keypad and that the device includes means for transmitting and receiving data. However, the Examiner argues that it would have been obvious to one having ordinary skill in the art to modify the system to

include a handset of a phone for dialing phone numbers from a keypad and means for transmitting and receiving data, for the advantage of providing an economically combined remote control/phone handset which additionally facilitates implementation of ordering cable TV services. The Examiner also states that claim 4 is met by switch 32 and the remote control mode of the Krisbergh device

By contrast, independent claim 1 of the present invention as amended relates to a remote control device for use with a transactional processing system having a receiver unit that receives information from a programming transmitter. The receiver unit also includes means for receiving and selecting desired programming selections. The remote control device comprises a housing forming an enclosure and a manually actuable keypad mounted on the housing. A control means is mounted in the enclosure and is operatively connected to the manually actuable keypad for receiving selected input data entered manually on the keypad corresponding to desired programming selections that are provided to the receiver unit by the programming transmitter.

The device also comprises a means for receiving financial information from a user of the remote control device and a transmitter means operatively connected to the control means. The transmitter means is configured to 1) transmit desired programming selections to the receiver unit corresponding to a selected keypad sequence so as to choose a desired programming and interact therewith through the manually actuable keypad, and 2) transmit the financial information to the receiver unit on a communication channel to authorize a desired transaction.

Respectfully, independent claim 1 of the present invention is not rendered obvious by Johnson and Hughes. Johnson discloses a remote control system including a hand-held remote control unit for controlling and communicating with a first controlled device, such as a digital music tuner, and a second controlled device, such as a set-top box, for the purpose of delivering music or video data to a television. In the disclosed system, a subscriber employs the remote-control device to control the display of the music/video on the television.

The Examiner states that Johnson "is interested in entering financial information at the remote control." However, the Examiner is incorrect. The "Buy" key shown in Figure 6 of Johnson and the text cited by the Examiner (col. 19, lines 46-53) do not disclose the transmission of financial information, but merely the transmission of a signal to the set-top box to proceed to transmit the music or video information. Thus, the remote control device of Johnson is not employed to transmit financial information.

Hughes discloses a terminal with a credit card swiping feature. A user swipes a credit card, and the information therefrom is transmitted via modem to a remote host system for the purpose of performing a transaction. Thus, Hughes may be employed to transmit financial information from the terminal. However, Hughes discloses the connection of the terminals via modem to a host system 80. The host system 80 is a central station which processes the transactional data in order to facilitate the ordering of products and services. By contrast, independent claim 1 of the present invention relates to a system wherein the financial information is received by the receiver unit when the user operates the remote control device.

The financial information of the present invention is not transmitted to a host system or central station, as in Hughes, but to a remote receiver unit, before it is transmitted to a remote site. Thus, Hughes does not disclose this feature of the present invention.

Most significantly, there is no suggestion, motivation or teaching in the prior art to combine the references as suggested by the Examiner. Specifically, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness as set forth in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966) and MPEP §706.02. To establish a prima facie case of obviousness the Examiner must show the following steps:

- (1) set forth the differences in the claim over the applied reference;
- (2) set forth the proposed modifications of the references which would be necessary to arrive at the claimed subject matter; and
- (3) explain why the proposed modification would be obvious.

To satisfy step (3), the Examiner must identify where the prior art provides a motivating suggestion to make the modifications proposed in step (2). In re Jones, 958 F. 2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to combine them. In re Bond, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). The mere fact that the prior art may be modified as suggested by the Examiner does not make the modification obvious, unless the prior art suggests the desirability of the modification. In re Fritch, 922 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). As explained in more detail

below, there is no motivating suggestion to modify these references, nor any suggestion as to how they can be modified, no matter how they are applied.

Most recently, the Court of Appeals for the Federal Circuit reiterated its position, in *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed.Cir. 1999) (hereinafter referred to as “Dembiczak”), holding that without a suggestion, teaching or motivation to combine prior art references cited against pending claims, a conclusion of obviousness, as a matter of law, cannot stand. In *Dembiczak*, the United States Court of Appeals for the Federal Circuit reversed the decisions of the Examiner and the Board of Patent Appeals and Interferences rejecting claims in a utility application as obvious over a combination of prior art references. The invention at issue in *Dembiczak* was a trash bag made of orange plastic and decorated with lines and facial features, allowing the bag, when filled with trash or leaves, to resemble a Halloween-style pumpkin or jack-o’-lantern. *Id.* at 1615.

The Board affirmed the Examiner’s final rejection of all of the independent claims under 35 U.S.C. 103, holding that they would have been obvious in light of conventional trash bags in view of other prior art references. *Id.* at 1616. In addition to conventional trash bags, some of the other prior art references which were relied on by the Board were a book entitled “A Handbook for Teachers of Elementary Art”, describing how to teach children to make a “Crepe Paper Jack-O-Lantern” out of a strip of orange crepe paper, construction paper cut-outs in the shape of facial features and wadded newspaper as filling, and a book entitled “The Everything Book for Teachers of Young Children”, describing a method of making a “paper bag pumpkin”

by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint. Id. at 15-16. Using this art, the Board held that all of Dembiczak's independent claims were obvious in light of the conventional trash bags in view of these references. Id. at 16.

The Court of Appeals, however, reversed the Board's decision on the grounds that, since there was no suggestion, teaching or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. Id. at 1618. Specifically, the Court of Appeals held that the obviousness analysis in the Board's decision was limited to a discussion of the ways that the multiple prior art references could be combined to read on the claimed invention, and that such a reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the [prior art] references teach or suggest [the] combination to yield the claimed invention. Id. at 1618. Thus, the Court of Appeals, found that there was no suggestion, teaching or motivation to combine the prior art references even though the prior art references disclosed all of the features of the claimed invention.

With respect to the pending claims in the present application, the references cited by the Examiner fail to provide any teaching or suggestion for combining Johnson and Hughes. Instead, the Examiner uses the present invention as a blueprint to find prior art that discloses the features of the present invention, without showing where in the cited prior art references there exists a suggestion, motivation or teaching to combine the references. The system disclosed by Johnson employs a hand-held remote control device to control the transmission of music and video data to

a subscriber. The subscriber does not submit financial data (as discussed above) via the remote control device because the subscriber's financial information is already known to the transmission source (e.g.- the cable television provider). The subscriber does not need to submit financial information because the cable provider simply adds additional charges to the subscriber's account. Since financial information is not required by this system, there is no motivation to combine the credit card swiping feature of Hughes. Thus, there is no motivation, teaching or suggestion for combining the two references.

Therefore, Applicant respectfully requests that the rejection of independent claim 1, and of claims 2-4, 6-9 and 46-47 that all depend either directly or indirectly on claim 1, be withdrawn by the Examiner.

Independent claim 51 of the present invention comprises the additional feature of a "means for storing financial information from a user of said remote control device." Except for this additional feature, claim 53 has the same features as claim 1. Thus, for the same reasons as explained in connection with claim 1 above, Applicant respectfully maintains that independent claim 51 of the present invention is not rendered obvious by Johnson in view of Hughes. Therefore, Applicant respectfully requests that the rejection of claim 51 be withdrawn by the Examiner.

Independent claim 52 of the present invention comprises the additional feature of a "means for inserting financial information from a user of said remote control device." Except for

this additional feature, claim 53 has the same features as claim 1. Thus, for the same reasons as explained in connection with claim 1 above, Applicant respectfully maintains that independent claim 52 of the present invention is not rendered obvious by Johnson in view of Hughes. Therefore, Applicant respectfully requests that the rejection of claim 52 be withdrawn by the Examiner.

Independent claim 53 of the present invention comprises the additional feature of an “input device which allows financial information from a user of said remote control device to be retrieved.” Except for this additional feature, claim 53 has the same features as claim 1. Thus, for the same reasons as explained in connection with claim 1 above, Applicant respectfully maintains that independent claim 53 of the present invention is not rendered obvious by Johnson in view of Hughes. Therefore, Applicant respectfully requests that the rejection of claim 53 be withdrawn by the Examiner. In addition, Applicant also respectfully requests that the rejection of claim 54, which depends from claim 53, be withdrawn by the Examiner.

Independent claim 55 of the present invention comprises the additional feature that the remote control device of the present invention is employed in a cable system. For the same reasons as explained in connection with claim 1 above, Applicant respectfully maintains that independent claim 55 of the present invention is not rendered obvious by Johnson in view of Hughes. Therefore, Applicant respectfully requests that the rejection of claim 55 be withdrawn by the Examiner.

Fees

Any additional fees or charges required at this time in connection with this application may be charged to Patent and Trademarks Office Deposit Account No. 12-2825.

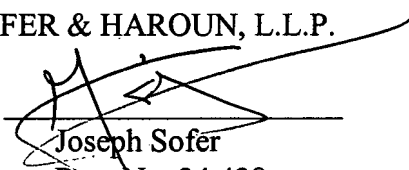
Conclusion

In view of the aforementioned amendment and remarks, it is respectfully submitted that all claims currently pending in the above identified application are now in condition for allowance, the earliest possible notice of which is earnestly solicited. If in the Examiner's opinion the prosecution of the present application would be advanced by a telephone interview, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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